

ROBERT H. DRAKE, JR.  
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May 16, 2003

**REMARKS**

Applicant encloses herewith in response to the rejection based on double-patenting a Terminal Disclaimer with respect to U.S. Patent No. 6,457,961, disclaiming the terminal portion of any patent issuing from this application beyond the expiration date of the '961 patent. In view of the Examiner's indication that the timely filing of the Terminal Disclaimer would overcome the double-patenting rejection, it is believed that this rejection should now be withdrawn.

The rejection of Claims 1-3, 7-9 and 13 as unpatentable over Drake, U.S. Patent No. 5,658,430 or U.S. Patent No. 5,849,387, each in view of Hamilton, U.S. Patent No. 5,693,400, is respectfully traversed. The discussion which follows addresses only the Drake '387 patent, since those two Drake patents are identical one to the other insofar as their disclosure is concerned. It will be appreciated that the present invention is concerned with a commercial carpeting system which can be readily and easily applied to and removed from a substrate, including a wooden floor, carpet tile, vinyl tile or the like. The carpeting system hereof includes a first flooring surface. A first pressure-sensitive adhesive is applied to the first surface. A layer of non-woven material is applied to the pressure-sensitive adhesive, providing a surface substantially impervious to moisture. On top of the layer of non-woven material, there is applied a carpet installation adhesive and a final piece of carpeting, for example, commercial carpeting, is adhesively secured to the second adhesive. This system enables the carpeting to be readily and easily removed from the substrate and replaced by similar carpeting using a similar system.

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In Drake '387, a new carpet is applied over an old, worn carpet by applying an adhesive over the face of the worn carpet. The new carpet is then directly overlaid onto the adhesive to complete the carpet installation (see col. 1, ll. 32-54; col. 4, ll. 8-31). There is no disclosure in the Drake '387 patent of a layer of non-woven material applied to a first pressure-sensitive adhesive and providing a surface substantially impervious to moisture. In short, the '387 Drake patent provides an installation, for example, of a six-foot carpeting with a PVC backing over an existing carpet by simply gluing the two carpets to one another. A separate non-woven material layer is not provided between the two carpets and is not necessary due to the existing carpet base layer, as well as the thickness and inherent dimensional stability of the PVC backing of the new carpet.

The Examiner identifies in the Hamilton '400 patent a carpet backing having a fiberglass non-woven fabric. It will be appreciated from the citations to the Hamilton patent by the Examiner that the fiberglass non-woven fabric is an integral part of the tufted or fusion-bonded carpet. In short, the Hamilton patent uses a non-woven fabric, for example, a fiberglass scrim-type material, adjacent to a non-woven glass fiber fleece layer (col. 1, ll. 57-58) in a finished carpet product where the backings are fused together to create a traditional carpet in a single sheet or roll form. The present invention, however, employs a separate, non-woven layer not fused to the backing of the new carpet and, hence, the claimed system is different than the traditional fused or tufted single layer of carpet of the Hamilton patent. The Hamilton patent describes the use of a single sheet of carpet intended for a standard glue-down procedure. The non-woven scrim layer simply provides stability to the finished carpeting and is integral

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with that finished carpeting. The present invention, however, requires a totally separate and independent non-woven layer not chemically fused to the new carpeting as in Hamilton to facilitate the removal of the new carpeting when that carpet is worn and must be replaced. Thus, the concept for the present system is contrary to the product disclosed in the Hamilton patent.

The Examiner states that it would have been obvious to insert the non-woven/PSA layer of Hamilton between the adhesive and flooring layers of Drake '387, providing as motivation the desire to increase dimensional stability of the Drake system and increase the cushioning effect. The Examiner, however, treats the non-woven/PSA layer of Hamilton as a separate discrete part of the Hamilton carpet installation, which it is not. The non-woven/PSA layer in Hamilton is an integral part of the carpet installation which is to be glued down to the substrate. The non-woven layer and both the first pressure-sensitive adhesive and the second adhesive, according to the present invention, are not integral parts of a carpet to be installed. They are separate and distinct. The Examiner dissects the Hamilton integral carpet construction to select the non-woven layer and the PSA and then applies those layers as discrete elements between the new carpet of Drake and the old carpet of Drake which, according to Drake, may be adhered to one another simply by the interposition of an adhesive. There is no teaching or motivation to dissect the Hamilton carpeting by selecting two of the multiple layers of his integral carpet and then interpose those selected layers between old and new carpeting as in Drake '387. The non-woven layer of Hamilton is integral to the carpet and provides dimensional stability which is

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necessary in the small area of the finished product, such as the carpet tile. However, that it provides dimensional stability in an integral carpet system does not render obvious its dissection and consideration as separate layers or elements for interposition between old and new carpeting as in Drake '387.

While applicant concedes that the discrete elements of a non-woven layer and a pressure-sensitive adhesive layer are *per se* known in the prior art, that does not, by itself, provide a predicate for selecting those elements, dissecting them from an integral carpet, and locating them in another type of carpet. As the Court in *In re Rouffet* stated:

[v]irtually all [inventions] are combinations of old elements. ... ("Most, if not all, inventions are combinations and mostly of old elements"). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Further, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as the blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." .(citation omitted)

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this Court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the invention and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

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Thus, the mere existence of a non-woven layer and pressure-sensitive adhesive does not provide the required motivation, particularly since it those elements are found in an integral carpet construction, not as separate layers as claimed.

It is noted that the increased dimensional stability which forms the predicate for the Examiner's conclusion of obviousness ignores the fact that the carpeting of Claim 1 is exclusive of the layer of non-woven material and is a separate component not fused to the finished carpeting as in Hamilton. Further, while the Examiner states that, as part of the predicate, the aspect of increasing a cushioning effect, it is noted that a non-woven layer does not provide increased cushioning. Any desire to provide increased cushioning would lead a person of skill in this art to utilize a carpet pad in the installation. The non-woven layer as set forth in Claim 1 provides for an easy release of the broadloom carpeting from the substrate when its useful life is at an end.

Claim 1 requires pressure-sensitive adhesive as the adhesive adhering the non-woven layer to the first flooring surface. Pressure-sensitive adhesive is not an adhesive that would have been obvious for use in broadloom carpet installation. Pressure-sensitive adhesives also have a much weaker bond than a multi-purpose adhesive and are used primarily for carpet tiles as in Hamilton, which have a very thick, heavy dimensionally stable backing. Broadloom carpets, on the other hand, are not dimensionally stable, will move, buckle and seams will pop up, etc., if a strong adhesive like a permanent multi-purpose adhesive is not used. The addition of a woven layer in the present system as claimed provides the dimensional stability that is needed for the

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broadloom carpet to allow it to be sufficiently adhered to the substrate using a pressure-sensitive adhesive.

The rejection of Claims 4-6, 10-12 and 14 as unpatentable over of the Drake '430 or '387 patents in view of Hamilton '400 and further in view of Helbling, U.S. Patent No. 4,857,566 is respectfully traversed. Once again, the Examiner finds an element in the prior art which corresponds to a claimed element and concludes the obviousness of applying that element to a claim which, in combination, requires a similar type element but without an appropriate teaching. That such element exists in the prior art does not, by itself, render inclusion of that element in a claimed combination obvious. Moreover, the Examiner states that the predicate for the conclusion of obviousness is that a person of skill in the art would have been motivated to "fill in the gaps in Hamilton's teachings and utilize an adhesive with improved moisture resistance." Where is the gap in the Hamilton teaching? The gap is demonstrated only because applicant claims an element in addition to subject matter in part disclosed in Hamilton. The so-called "gap" is non-existent until applicant's claims are read by the Examiner and the Examiner notes a lack of disclosure in Hamilton of shredded fiberglass. Secondly, why does Hamilton require improved moisture resistance in its PSA, particularly since the backing of the integral carpeting of Hamilton is a PVC material? In any event, the addition of Helbling to the combination of either the Drake patents and Hamilton does not make up for the foregoing noted deficiencies or the lack of teaching for the combination of references.

Added Claims 15 and 16 are directed to particulars of the non-woven layer and are not believed disclosed in the applied references.

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Accordingly, reconsideration and allowance of the claims presently pending in the application is respectfully requested.

Respectfully submitted,

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